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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,375	02/25/2002	James Cannon Bible	018279.046956	4567

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EXAMINER

TSOY, ELENA

ART UNIT

PAPER NUMBER

1762

DATE MAILED: 05/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/082,375

Applicant(s)

BIBLE ET AL.

Examiner

Elena Tsoy

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 10-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4. 6) ☐ Other: \_\_\_\_\_

### ***Election/Restrictions***

Applicant's election with traverse of Claims 1-12 in Paper No. 6 is acknowledged. The traversal is on the ground(s) that the Examiner's statement that a process as claimed can be practiced by another materially different apparatus comprising one EB emitter and rotating means instead of a plurality of EB emitters to achieve the same even exposure of all coated surfaces to radiation is incorrect because no rotating means for an EB emitter presently exists. This is not found persuasive because, according to MPEP, a test for restriction is that if a process as claimed can be practiced using any other possible apparatus (no matter the apparatus currently exists or not), the restriction is proper.

The examiner made an error in Election/Restriction requirement mailed on February 27, 2003 by including claims 10-12 into Group I since a method of claims 10-12 cannot be practiced with apparatus other than apparatus of claim 17 of Group IV. Therefore, they should be examined together with Group IV.

Upon a new Restriction request by telephone to Alexander P. Brackett on May 16, 2003, a provisional election was made with traverse to prosecute the invention of Group I, now claims 1-9. Affirmation of this election must be made by applicant in replying to this Office action. Claims 10-25 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Drawings***

1. The drawings are objected to because continuous length of material 1 is absent. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

*Specification*

2. The disclosure is objected to because of the following informalities: page 12, line 3, a phrase “**either** electron-beam coatings ... **and** ultraviolet curable coatings” seems to be incorrect. Appropriate correction is required.

*Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1, 2, 4, 8, 9** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ostrowski (US 3,965,551) in view of Maddox et al (US 6,306,468).

As to claims 1, 2, 4, 8, 9, Ostrowski discloses a process for coating a steel tubing (See column 1, lines 5-8) comprising applying tension to a portion of the steel tubing by employing a take-off assist device of specific construction (See column 1, lines 29-47; column 6, lines 6-19; column 7, lines 14-23), applying a thermally curable coating to the portion of the steel tubing while advancing the portion through a coating system (See Fig. 1; column 3, lines 22-25), and curing the coating (See column 3, lines 46-55; column 4, lines 48-57). The process further comprises washing, rinsing and drying the tubing (under tension) prior to coating (See column 2, lines 31-45) and applying galvanizing material such as zinc alloy (sealer) and optionally zinc chromate coating to provide even greater resistance to oxidation (See column 2, lines 50-65; column 3, lines 3-9).

Ostrowski fails to teach that a coating is electron-beam curable material.

Maddox et al teach that the use of electron beam equipment and modified acrylic unsaturated coating compositions for free radical curing will reduce energy consumption for coating the exterior surface of tubing. The faster rate of polymerization of this coating composition allows for the replacement of a conventional oven or induction heater unit with an electron beam unit requiring much less floor space and generating much less heat. See Abstract.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used electron-beam curable material instead of thermally curable coating in Ostrowski with the expectation of providing the desired reduced energy consumption, as taught by Maddox et al.

5. **Claims 3, 5-7** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ostrowski (US 3,965,551) in view of Maddox et al (US 6,306,468), as applied above, and further in view of Asai et al (US 6,103,317).

Ostrowski in view of Maddox et al, as applied above, fails to teach that the process can be used for coating a steel sheet (Claim 3), metallic or non-metallic cable (Claims 5, 7), or non-metallic tubing (Claim 6).

Asai et al teach that polymeric cable or tubes or any other (continuous) articles (See column 2, lines 52-58) are suitable for coating continuously with electron-beam curable material (See column 8, lines 30-31).

It is held that the selection of a known material based on its suitability for its intended use supported a prima facie obviousness determination in Sinclair & Carroll Co. v. Interchemical Corp., 325 U.S. 327, 65 USPQ 297 (1945). See also In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960) (selection of a known plastic to make a container of a type made of plastics prior to

the invention was held to be obvious); *Ryco, Inc. v. Ag-Bag Corp.*, 857 F.2d 1418, 8 USPQ2d 1323 (Fed. Cir. 1988).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have coated any continuous article including a metal sheet, non-metallic tube, metallic or non-metallic cable using a method of Ostrowski in view of Maddox et al since Asai et al teach that any continuous article is suitable for coating continuously with electron-beam curable material.

### *Conclusion*

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy whose telephone number is (703) 605-1171. The examiner can normally be reached on 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on (703) 308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

*Elena Tsoy*

Elena Tsoy  
Examiner  
Art Unit 1762

May 19, 2003

<b>Interview Summary</b>	Application No.	Applicant(s)	
	10/082,375	BIBLE ET AL.	
	Examiner	Art Unit	
	Elena Tsoy	1762	

All participants (applicant, applicant's representative, PTO personnel):

- (1) Elena Tsoy. (3) \_\_\_\_\_  
 (2) Alexander P. Brackett. (4) \_\_\_\_\_

Date of Interview: 16 May 2003.

Type: a) ☒ Telephonic b) ☐ Video Conference  
 c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☐ No.  
 If Yes, brief description: \_\_\_\_\_.

Claim(s) discussed: 10-12.

Identification of prior art discussed: \_\_\_\_\_.

Agreement with respect to the claims f) ☒ was reached. g) ☐ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: Due to inadvertent error in Election/Restriction requirement mailed on February 27, 2003, the examiner put a new Restriction request. Applicants reelected Group I, now claims 1-9.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

\_\_\_\_\_  
 Examiner's signature, if required